

### **Invention Prior to the Effective Date of the References (MPEP 715)**

As established by the attached Rule 1.131 Declaration of Bjarke de Jager Gotfredsen ("Gotfredsen Declaration") and the Corroborating Declaration of Poul Lyngsø ("Lyngsø Declaration"), the invention covered by the present application was made before the effective date of both the Lester and Braun references. Therefore, these references should not be considered prior art against the present invention, and all claims should be allowed. *See* 37 C.F.R. 1.131. Since all the claim rejections rely on either Lester, Braun, or both, it is sufficient to antedate only these references, and not House. *See* MPEP 715.02. ("[a]pplicant may overcome a 35 U.S.C. 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references.")

The effective date of Lester is April 1, 1998, and the effective date of Braun is November 14, 1997. MPEP 706.02(a). As shown below, the inventor for the present application, Bjarke de Jager Gotfredsen, reduced his invention to practice by June or July, 1997, well before the earlier Braun reference. Gotfredsen Decl. ¶ 4. Additionally, the applicant's priority date, based upon his Danish application, is May 15, 1998, and therefore there could be no statutory bar. *See* MPEP 706.02(b). (The examiner has correctly cited 35 U.S.C. § 102(e) rather than 35 U.S.C. § 102(b)).

The present invention is a mouse pad with a device for reading and/or writing data storage units, such as "smart cards." The inventor, Mr. Gotfredsen, conceived of this invention in April, 1997 in Hørsholm Denmark. *Gotfredsen Decl.* ¶ 1. Denmark is a WTO country, and therefore Mr. Gotfredsen's inventive acts in that country can be used to antedate prior art references. *See* 37 C.F.R. 1.131(a) ("[p]rior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country").

After conceiving of his invention, Mr. Gotfredsen worked to reduce it to practice, and created three first generation prototypes in May, 1997. *Gotfredsen Decl.* ¶ 3. These first generation prototypes were fully operating smart card read/write devices, but they were not yet incorporated within a mouse pad. *Id.* Mr. Gotfredsen has saved one of these three prototypes, and has included photographs of it as Exhibit 1 to his declaration. *Id.* This surviving first generation prototype is currently at Mr. Gotfredsen's present home in South Africa. *Id.*

This first-generation prototype is corroborated not only by the Gotfredsen Declaration and the device itself, but also by a receipt for smart cards purchased on

May 22, 1997, shortly after the device was built. *See* Gotfredsen Decl. ¶ 3 and Exh. 2.

After building the first generation prototype, Mr. Gotfredsen worked to improve the device, by making it less bulky, and by incorporating it into a mouse pad. *See* Gotfredsen Decl. ¶ 4. Accordingly, in June or July 1997, Mr. Gotfredsen built a second-generation prototype, which was a fully operating smart card read/write device incorporated into a mouse pad. *Id.* Thus, the invention of the present application was reduced to practice by July, 1997, well before either the Braun or Lester reference.

Mr. Gotfredsen showed this second generation prototype to family and friends in August, 1997. *Id.* One person who viewed the second generation prototype was Mr. Gotfredsen's business partner, Poul Lyngsø. *See* Corroborating Declaration of Poul Lyngsø, filed herewith.

Thereafter, Mr. Gotfredsen worked to develop his invention, by preparing a rough draft business plan in November, 1997 that describes the present invention among other potential products. Gotfredsen Decl. ¶ 5; Exhs. 3a and 3b. Mr. Gotfredsen also produced a final business plan describing the product and met with Danish patent counsel about protecting the invention. *See* Gotfredsen Decl. ¶¶ 5 & 6; Exhs. 4 -6.

These activities, which are proved by Mr. Gotfredsen's Declaration, Mr. Lyngsø's Declaration, and the supporting documentation, establish reduction to practice by July 1997, well before the effective date of Lester and Braun. Therefore, the applicant respectfully requests that both the Braun and Lester references be disregarded, because the applicant's invention antedates both references. With both of these references removed as prior art, the rejections cannot stand.

### **Traversal**

The applicant also respectfully traverses the rejections on the grounds that the cited prior art does not contain the elements in question.

In particular, the present application is directed towards a mouse pad having a data storage read/write device. (*See* e.g. Claim 3 "A mouse pad unit comprising a mouse pad and a card read/write device integrated with said mouse pad"). Neither Lester nor Brain, singly or together, recite or suggest this invention.

### ***Lester***

Lester is directed towards a telephone integrated with a mouse pad. The examiner has noted that Lester refers to a "telephone card" (Col. 6: 9 - 20), and the

examiner has inferred that this card is a data storage card that can be read by a read/write unit embedded in mouse pad. However, the context of the Lester patent makes clear that (i) this "telephone card" is not a data storage card, but is instead an expansion board, (ii) the "telephone card" card interfaces with the computer, not the mouse pad, and (iii) there is no read/write device in Lester's mousepad.

As to the first point, Lester states that the "telephone card" provides "telephone functionality," thus allowing the computer to function as a telephone. (Col. 6:13). Thus, Lester's "telephone card" is not a data storage card, but an expansion circuit board that adds new functionality to a computer.

As to the second point, Lester's "telephone card" interfaces with *the computer, not the mouse pad*. Specifically, Lester states that "[t]he **computer** includes a known telephone card 951." (Col. 6: 10, emphasis added). Lester says nothing about the **mousepad** having a telephone card, and indeed his illustrations show the "telephone card" 951 interfacing with the computer 950, *not* the mousepad 900. See Fig. 9.

As to the third point, Lester does not describe any sort of read/write device associated with the mouse pad, unlike the present invention. Thus, even if Lester's "telephone card" were some sort of data storage unit, there is nothing in Lester's mouse pad to read it or to write to it.

For these reasons, Lester does not anticipate any of the applicant's claims under 35 U.S.C. § 102. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984) ("[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim").

#### ***Braun and House Combined With Lester***

Likewise, neither Braun nor House teach or suggest integration or interfacing between a mouse pad and a read/write device. Instead, as the examiner correctly points out, Braun discloses a computer with various types of computer readable media. But nothing in Braun suggests incorporating any sort of read/write device into a mouse pad to enable it to read/write such media. Similarly, although House's mousepad has an advertisement on its exterior surface, it does not have any sort of device for reading or writing smart cards or any other data storage units.

Thus, none of the three references teach or suggest integrating or associating a read/write device with a mousepad, and thus they do not anticipate or render the

present invention obvious.

*Conclusion*

For the reasons stated above, the present application has not been anticipated or rendered obvious by the cited prior art, and is ready for early allowance.

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By: *Daniel P. Maguire*  
Daniel P. Maguire, Reg. 41,506  
Tel: (530) 750-3661